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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

Docket No. 595

FERNANDA MISANI,

Plaintiff-Appellant,

vs.

ORTHO PHARMACEUTICAL CORPORATION, a New Jersey corporation, JOHNSON & JOHNSON, a New Jersey corporation, ROBERT W. JOHNSON, HARRY C. McKENZIE, BERTON J. TODD, EVAN R. SPALT, JOHN FRIEBELY, and WILLIAM OROSHNIK,

Defendants-Appellees.

On Appeal from the Supreme Court of New Jersey

PETITION FOR REHEARING

FERNANDA MISANI,
Plaintiff-Appellant, pro se,
40 Tamaques Way,
Westfield, New Jersey.

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IN THE

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OCTOBER TERM 1965

Docket No. 595

FERNANDA MISANI,

Plaintiff-Appellant,

v.

ORTHO PHARMACEUTICAL CORPORATION,
a New Jersey Corporation, *et als.*,

Defendants-Appellees.

Petition for Rehearing

Fernanda Misani, appellant, prays that this Court grant a rehearing of its Order of December 6, 1965, which dismissed the appeal for want of jurisdiction and treating the papers whereon the appeal was taken, as a petition for certiorari, denied certiorari.

In her petition for enlargement of the time within which to file the petition for rehearing, appellant urged that the two cases, *Brenner* v. *Manson*, —— U. S. ——, decided March 21, 1966, 34 U. S. Law Week 4221, and *Walker Process Equipment Inc.* v. *Food Machinery and Chemical Corporation*, 382 U. S. 172 (1965), involve issues identical to

the present case. At the time of the petition for extension of time, no decision had been rendered in *Brenner* v. *Manson, supra,* and the *Walker* case had been unanimously reversed by this Court on December 6, 1965.

By Order of Justice Brennan, dated December 18, 1965, the time within which to file the petition for rehearing was extended for a period of twenty days beyond the decision of this Court in *Brenner* v. *Manson, supra.*

Certificate

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58(2) of the Rules of this Court, that is, to the issues decided by this Court in the intervening decision in *Brenner* v. *Manson,* —— U. S. —— (1966), 34 U. S. Law Week 4221, and the decision in *Walker Process Equipment Inc.* v. *Food Machinery and Chemical Corporation,* 382 U. S. 172 (1965) decided December 6, 1965.

FERNANDA MISANI

April 8, 1966

Reasons for Granting Rehearing, Noting Probable Jurisdiction, or Issuing the Writ

Subsequent to the Order of December 6, 1965, which dismissed the appeal and denied certiorari, this Court has passed on the identical issue of the requisites of patentability in *Brenner* v. *Manson*, —— U. S. —— (1966), 34 U. S. Law Week 4221. This intervening decision, which reversed the judgment below, is controlling. In *Brenner*, this Court, citing 35 U. S. C. 101, has held that no patent may be granted on a product, unless the product is shown to be useful:

> "The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived to the public from an invention with substantial utility."

The obvious corollary of this holding is that the inventor of a novel chemical compound is the individual who conceived the idea of making the compound, made it, and discovered the utility.

I: The holding of the New Jersey Supreme Court that an individual may obtain a patent on a product, without a process for manufacturing the product and without a showing that the product has utility, is in conflict with the holding of this Court in *Brenner* v. *Manson*, —— U. S. —— (1966), 34 U. S. Law Week 4221 and invalidates 35 U. S. C. 101, 112 and 154.

In the present case, a patent U.S.P. 2,878,263 (Jurisdictional Statement at p. 14*) issued in 1959, claiming the

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* References in this petition are to the Jurisdictional Statement, Reply Brief in Opposition to Appellees' Motion to Dismiss the Appeal, and Appendixes A, B, C, D and E annexed thereto.

novel product 4-methyl 4-phenyl-5-pyrazolone. The patent describes in full detail the novel process of manufacture of the product and its novel properties in curing a serious disease, convulsions. The novel compound was the invention of the plaintiff, appellant herein, a senior chemist, the holder of a doctorate in Organic Chemistry, and with long experience in the particular field of this invention. The patent, however, designates Oroshnik, one of the defendants-appellees, as the inventor.

Oroshnik has alleged, with no proof whatsoever, that he merely conceived the idea of making the compound, but admits that he did not know how to manufacture the product, did not make it, and did not discover the novel use of the product. It is not disputed that the patent is based upon appellant's successful original scientific contribution and experimentation (Appendix C at 12a; Appendix B at 6a). Under the holding of this Court in *Brenner* v. *Manson, supra,* Oroshnik cannot be the inventor. Even assuming, for the sake of argument, that he conceived the idea of making the compound, a patentable invention requires the actual making of the compound and a showing of utility. The successful manufacture of the compound is, of course, a prerequisite before the compound may be tested, and the utility determined. U.S.P. 2,878,263 would not have issued in Oroshnik's name or anybody else's name, without the full description of the novel process for the manufacture of the substance and the novel properties of the substance as an anticonvulsant.

This action was brought for deprivation of intellectual credit, for the failure to designate the plaintiff as the inventor, and for fraud on the United States Patent Office for obtaining a patent with the false oath of one who was not the inventor.

According to the trial judge, no cause of action for deprivation of intellectual credit exists, and a scientist-employee, who has agreed to assign proprietary rights to the employer "*forfeits*" the right to have his or her name as the inventor in the patent (Jurisdictional Statement, at p. 7, 30). The Appellate Division of New Jersey reversed that monstrous and unconstitutional holding. That court properly held that a United States patent must be accompanied by the oath of the actual inventor, 35 U.S.C. 102(f); 35 U.S.C. 111; 35 U.S.C. 115; and that the right of inventorship is guaranteeed both by federal law and common law principles (Appendix C, 16a to 19a; Appendix D at 44). Further, the Appellate Division properly held that a patentable invention of a new compound requires, not only conception of the idea, but the making of the compound and a showing that it is useful (Appendix C, 19a).

The Supreme Court of New Jersey, however, has reversed the Appellate Division. It has held that the conception of idea of making a new compound, without the actual reduction to practice, and without the showing of utility, is sufficient for a patentable invention (Appendix B, 6a). The Supreme Court of New Jersey recognizes that the patent is based on appellant's scientific contribution, but relieves appellees from liability merely because "*the patent claim (one line) in U.S.P. 2,878,263 was carefully limited to the compound itself and did not extend to the process and use*" (Appendix B, at 7a; Jurisdictional Statement at 22 to 36). Thus, according to the Supreme Court of New Jersey, it is proper to obtain a patent on a new compound without the making of the compound and without a showing that the compound is useful. Further, according to the Supreme Court of New Jersey, it is proper for an employer to secure a patent in the name of one employee, merely because he alleges, without proof whatsoever, that he conceived the idea of making the compound, where the

employer knows that another employee, not only conceived the idea, but successfully devised the means for making the compound and discovered the novel valuable use.

Thus, under the holding of the Supreme Court of New Jersey, an employer, in securing a patent in the name of one employee, may incorporate in the patent the successful experimentation of another employee, without which no patent would issue. It is submitted that the holding of the New Jersey Supreme Court ratifies a policy by the employer of deliberately obtaining patents with false oaths of one who is not the inventor, fraud on the United States Patent Office, and invalidation of federal law.

II. Under the holding of this Court in *Walker Process Equipment, Inc.* v. *Food Machinery and Chemical Corporation*, 382 U. S. 172 (1965), respondents-appellees have violated the antitrust laws, 15 U. S. C. 15, and should be liable for treble damages.

1. In the *Walker* case, this Court has unanimously held that delay in filing a patent application for more than one year after the invention has been exploited and introduced into public use, is a violation of 35 U.S.C. 102(b) and 102(c), and the inventor, or anyone claiming under him, forfeits the right to a monopoly on his invention. The fraud in the sworn allegations in the oath accompanying the application for the patent, makes the monopoly illegal and a violation of the antitrust laws. 15 U.S.C. 15. The injured party has a right to treble damages under the Clayton Antitrust Act.

The statutory provisions, 35 U.S.C. 102(b) and 102(c), pertain to loss of the right to a patent because of the delay in filing the application. In the present case, the same fraud and delay in filing undisputably exist. It is a fact that appellant, in December 1955, conceived the idea of mak-

ing the substance described and claimed in U.S.P. 2,878,263, and in April, 1956, she successfully reduced the idea to practice, synthesized the substance by a noval process and discovered the valuable properties as an anticonvulsant. She was maliciously discharged three days later. It has not been contested that Johnson & Johnson's legal staff, in April 1956, prepared the patent application based on appellant's invention but did not file it in the United States Patent Office until two years later, February 1958 (Jurisdictional Statement, at p. 33). Appellees' delay in filing the patent application is identical to the *Walker* case, *supra*, and constitutes an illegal monopoly. 15 U.S.C. 15. The reason for the delay, according to their own admissions, was suppression of the invention and concealment, for malicious motives.

Our patent laws require that the inventor or anyone claiming under him, must content himself with either secrecy or legal monopoly. He must act with speed and diligence in filing the application for a patent or his rights to a legal monopoly are forever barred. The condition for securing a patent is giving the public the fruits of the invention as soon as possible, and preventing concealment and abandonment. This object was set forth in *Pennock* v. *Dialogue*, 27 U. S. 2 (Pet) 1, 19 (1829); *Woodbridge* v. *United States*, 263 U. S. 50 (1923); *Kendall* v. *Winsor*, 62 U. S. 322 (1858); *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U. S. 502 (1917). The same rationale is at the basis of this Court's decision in *Walker*.

The New Jersey courts have reached a result totally conflicting with our antitrust and patent laws, 15 U. S. C. 15, 35 U. S. C. 102(b) and 102(c), and the *Walker* holding of this Court. They have expressly held that an employer has a legal right to delay in filing applications for patents, conceal invention of employees, abandon them, *"throw*

them out of the window", "scrap" them and long time after, secure patent rights at its *"unfettered will"* (Appendix B at 3a; Appendix C at 14a; Jurisdictional Statement at 33-34). The statutory duty of promptly filing the application for a patent does not apply to the employer. It is submitted that the holding of the New Jersey courts is a ratification of an illegal monopoly and must be reversed.

2. In *Walker Process Equipment Inc.* v. *Food Machinery and Chemical Corporation,* this Court has said that an assignee, who maintains and enforces a patent with knowledge of its infirmity, violates the antitrust laws. 15 U. S. C. 15. Under this holding, appellees have violated the antitrust laws and appellant is entitled to treble damages.

Johnson & Johnson before the New Jersey courts and as late as their brief in support of their motion to dismiss the appeal before this Court, has argued that U.S.P. 2,878,263 is invalid (Appellees' brief at 4, 7, 9, 10; Appendix B at 5a; Appendix C at 13a, 18a), but has retained and maintained the illegal monopoly, and has refused to disclaim it. 35 U. S. C. 253. The refusal to disclaim has been deliberate. Before the New Jersey courts, Johnson & Johnson has said:

> "We could disclaim, but that is solely within our privilege to do so or not to do so, we are the owners of the patent." (Jurisdictional Statement at p. 36)

Also Food Machinery and Chemical Corporation in *Walker, supra,* was the owner of the patent. Yet, in a belated, but at least good faith gesture, it moved to withdraw its complaint and has forfeited the right to a monopoly. In direct contrast, the New Jersey courts have ratified the arbitrary power of the employer to retain an illegal monopoly and violation of our antitrust laws. They have said:

> "She has no right to say [that they should disclaim it] . . . that is their business, that is not her business. . . . If they want [to disclaim it] they can do it, and if they don't want to, they don't have to do it and she has no rights on that." (Appendix C at 15a; Jurisdictional Statement at 37)

Thus, the New Jersey courts, in clear conflict with the holding in *Walker,* permit an employer to retain and enforce an invalid patent, and simultaneously deny damages to the injured employee.

3. Unless the conflict between *Walker* and the present case is eliminated, the dismissal of the appeal amounts to an illegal discrimination against the large class of scientists, the employed inventors, and in favor of the employers. This discrimination is against the very class of individuals, who, by their initiative and inventive ability, coupled with extensive academic training, are credited with giving our country its superior technological position. They are the thousands of individuals whom the Constitution, U. S. Const., Art. 1, Sec. 8, Cl. 8, and our patent laws, are designed to protect.

In *Walker,* this Court has distinguished between the actual fraud, the willful and deliberate submission of a false oath and the honest errors, which are classified as technical fraud, for which this Court relieves the patentee from liability. Application of this rule to the present case, undisputably leads to a reversal, just as in *Walker.* Johnson & Johnson knew and has admitted that Oroshnik was not the inventor, and knew that they would have lost the interference proceeding before the Board of Interferences in the United States Patent Office (Jurisdictional Statement at pp. 11-13, 29). This is not an honest error, but actual knowledge that Oroshnik was not the inventor and that the

sworn allegation by Oroshnik in the application which issued as U.S.P. 2,878,263, was false and a fraud upon the United States Patent Office.

III. This Court has jurisdiction of this appeal.

The dismissal of this appeal for want of jurisdiction, as stated in the Order of December 6, 1965, implies that according to this Court, the federal questions were not raised below or that the New Jersey courts have, neither expressly nor impliedly, passed on the validity of federal statutes. The Court is respectfully urged to reconsider this ground of dismissal.

The Supreme Court of New Jersey has certified that the federal questions were timely and properly argued below (Appendix E, appended to appellant's reply brief), has not attempted to rest its decision on an independent non-federal ground, and has cited 35 U. S. C. 112 (Appendix B, at 6a). The Supreme Court of New Jersey, however, in passing upon the federal questions, has essentially invalidated federal law.

CONCLUSION

It is respectfully urged that rehearing be granted and probable jurisdiction be noted or a writ of certiorari issue to the Supreme Court of New Jersey.

Unless the order of dismissal of the appeal is reversed, the disposition below of this case is in sharp conflict with the decision of this Court in *Walker Process Equipment Inc.* v. *Food Machinery and Chemical Corporation*, 382 U. S. 172 (1965), and *Brenner* v *Manson*, U. S. (1966), 34 U. S. Law Week 4221.

An employer, according to the New Jersey courts, has no duty to file patent applications promptly, is free to "*scrap*" inventions of employees and long time afterwards,

is permitted to secure patent rights. An employer may obtain patents with false oaths by one who is not the inventor, has no duty to disclaim an invalid patent and is permitted to prolong the monopoly beyond the seventeen-year period (Jurisdictional Statement, at page 22).

According to the New Jersey courts, the employee-inventor has no right to have his or her name on a patent, and is not permitted to prove the extent of damages for the delay in filing the patent application and for the willful and malicious concealment of his or her inventions.

Respectfully submitted,

FERNANDA MISANI,
Appellant-Petitioner, pro se.

END